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REMARKS/ARGUMENTS

Claims 1-12 are pending in this application. By this Amendment, Applicants amend Claim 1 and cancel Claims 13-65.

Claims 13-65 have been canceled since Claims 13-65 are directed to a non-elected invention. Applicants reserve the right to file a Divisional Application in order to pursue prosecution of non-elected Claims 13-65.

Claims 1-10 and 12 were rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over Claim 14 of U.S. Patent No. 6,879,086.

In the accompanying Terminal Disclaimer, Applicants have disclaimed the terminal portion of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as shortened by any terminal disclaimer filed prior to the grant of commonly owned U.S. Patent No. 6,879,086. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1-10 and 12 under the judicially created doctrine of double patenting as being unpatentable over Claim 14 of U.S. Patent No. 6,879,086.

In addition, Applicants submit a Declaration under 37 C.F.R. § 130 which declares that the present invention and U.S. Patent No. 6,879,096 were commonly owned at the time the present invention was made to preclude a rejection of the claims under 35 U.S.C. § 103(a).

Claims 1-4, 6-10, and 12 were rejected under 35 U.S.C. § 102(e) as being anticipated by Takamine (U.S. 6,879,086). Claims 1-3, 6-8, and 10-12 were rejected under 35 U.S.C. § 102(a) as being anticipated by Nakamura et al. (JP 2003-332874). Claims 1-3, 6-9, and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by Matsuda (JP 2000-138553). Claims 5 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakamura et al. Claims 1, 3, 5-7, and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Takeno et al. (U.S. 4,065,734) in view of

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Ieki et al. (U.S. 4,037,181). Applicants respectfully traverse the rejections of Claims 1-12.

Claim 1 has been amended to recite:

A surface acoustic wave filter comprising:
a piezoelectric substrate;
an insulating pattern disposed on the piezoelectric substrate
and having permittivity less than that of the piezoelectric substrate; and
a conductor pattern disposed on at least one of the
piezoelectric substrate and the insulating pattern; wherein
a portion of the conductor pattern defines IDTs and another
portion of the conductor pattern defines wiring traces; and
**at a portion where wiring traces are arranged in parallel,
have different potentials, and face each other in a plan view, at least
a portion of at least one of the wiring traces is disposed on the
insulating pattern.** (emphasis added)

Support for the amendment to Claim 1 is found, for example, in Fig. 1 of the originally filed application.

With the unique combination and arrangement of features recited in Applicants' Claim 1, including the features of "at a portion where wiring traces are arranged in parallel, have different potentials, and face each other in a plan view, at least a portion of at least one of the wiring traces is disposed on the insulating pattern," Applicants have been able to provide a surface acoustic wave filter in which a portion of the conductor pattern is disposed on the insulating pattern, the portion on the insulating pattern is not directly in contact with the piezoelectric substrate having a high permittivity and is held on the piezoelectric substrate through the insulating pattern having a lower permittivity than that of the piezoelectric substrate. Accordingly, parasitic capacitance between that portion and another portion of the conductor pattern is reduced by the insulating pattern (see, for example, the last full paragraph on page 4 of the originally filed specification).

Applicants enclose a Declaration under 37 C.F.R. § 132 which declares that Yuichi TAKAMINE is an inventor in the present application, invented all of the subject

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matter disclosed in U.S. Patent No. 6,879,086 and relied on in a prior art rejection of Claims 1-4, 6-10, and 12 in the present application, and invented the common subject matter disclosed in U.S. Patent No. 6,879,086 and the present application. Accordingly, Applicants respectfully submit that Takamine (U.S. 6,879,086) is disqualified as prior art in the present application.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1-4, 6-10, and 12 under 35 U.S.C. § 102(e) as being anticipated by Takamine (U.S. 6,879,086).

In accordance with MPEP § 201.15, Applicants have provided herewith a certified English translation of the Japanese Priority Application, JP 2003-046269, and a statement that the translation of the certified English translation is accurate. Thus, Applicants respectfully submit that Nakamura et al. (JP 2003-332874) is disqualified as prior art under 35 U.S.C. § 102(a) because the publication date of May 15, 2003 of Nakamura et al. (JP 2003-332874) is after the effective filing date of February 24, 2003 of the present application.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1-3, 6-8, and 10-12 under 35 U.S.C. § 102(a) as being anticipated by Nakamura et al. (JP 2003-332874), and the rejection of Claims 5 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Nakamura et al.

Applicants have amended Claim 1 to recite the feature of “at a portion where wiring traces are arranged in parallel, have different potentials, and face each other in a plan view, at least a portion of at least one of the wiring traces is disposed on the insulating pattern.”

In contrast to Applicants' Claim 1, as clearly seen in Fig. 5 of Matsuda, the element 6 of Matsuda, which the Examiner alleged corresponds to a signal wiring trace, is disposed on and electrically connected to the wiring pattern 9. In other words, at the portions of the wiring traces that have different potentials and that face each other, the wiring traces are disposed on another wiring pattern, not on an insulating pattern.

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Thus, Matsuda certainly fails to teach or suggest the feature of “at a portion where wiring traces are arranged in parallel, have different potentials, and face each other in a plan view, at least a portion of at least one of the wiring traces is disposed on the insulating pattern” as recited in Applicants’ Claim 1.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1-3, 6-9, and 12 under 35 U.S.C. § 102(b) as being anticipated by Matsuda.

The Examiner alleged that Takeno et al. teaches all of the features recited in Applicants’ Claim 1, except for wiring traces that where wiring traces with different potentials face each other in plan view, at least one is disposed on the insulating pattern. The Examiner further alleged that Ieki et al. “shows wiring traces for connecting the IDTs to terminals 4-7 wherein 4 and 5 and necessarily of opposite potentials to excite the IDT 2.” Thus, the Examiner concluded that it would have been obvious “to have modified the SAW filter of Takeno et al. (Fig. 1A, if even necessary, to have wiring traces for connecting the IDTs 13 and 14 to terminals for connection to external devices as suggested by the exemplary teaching thereof by Ieki et al.”

As noted above, Claim 1 has been amended to recite the feature of “at a portion where wiring traces are arranged in parallel, have different potentials, and face each other in a plan view, at least a portion of at least one of the wiring traces is disposed on the insulating pattern.”

Takeno et al. nor Ieki et al. fail to teach or suggest anything at all about the specific arrangement of wiring traces having different potentials, and certainly fail to teach or suggest the features of “at a portion where wiring traces are arranged in parallel, have different potentials, and face each other in a plan view, at least a portion of at least one of the wiring traces is disposed on the insulating pattern” as recited in Applicants’ Claim 1. In contrast, at best, Ieki et al. merely shows a schematic representation of the terminals 4-7, and fails to show any specific structural arrangement of the terminals 4-7.

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Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1, 3, 5-7, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Takeno et al. in view of Ieki et al.

In view of the foregoing amendments and remarks, Applicants respectfully submit that Claim 1 is allowable. Claims 2-12 depend upon Claim 1, and are therefore allowable for at least the reasons that Claim 1 is allowable.

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

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